

REMARKS

Claims 1-13 and 15-17 are pending. Reconsideration and allowance of the present application based on the following remarks are respectfully requested.

By this Amendment, Applicants respectfully request amendment of the specification to add the parent application's serial number which was unavailable at the time of filing and to complete the recitation of the benefit claim. This amendment was made by Rule 312 Amendment on August 26, 2004 although it is not clear from the record whether that Rule 312 Amendment was entered. If the Rule 312 Amendment is already entered, then please ignore the amendment to the specification herein.

Applicants are surprised to note that the Examiner has withdrawn the allowability of claims 1, 10 and 15. Applicants respectfully submit that the newly applied reference is almost entirely irrelevant to the claimed invention and that the newly stated grounds of rejection fail to set forth a proper *prima facie* case of obviousness. In particular, contrary to MPEP 2143.01, the proposed modification would render the Tanaka system unsuitable for its intended purpose.

The Office Action improperly combines Tanaka (EP 1020897) with Klebanoff (US 6533952). References cannot properly be combined with each other when such would result in destroying that on which the invention of one of the references is based. Ex parte Hartmann, 186 USPQ 366, 367 (PTO Bd.App. 1974). The proposed combination is apparently to use the hydrocarbon of Klebanoff along with the gas system of Tanaka. This is entirely contrary to the teachings of Tanaka and such a combination would destroy that on which Tanaka is based. In particular, Tanaka teaches that a gas supply device 150 is used for filling spaces formed between optical elements in a lens barrel "*with an inert gas.*" Emphasis added, see, Abstract. Tanaka further teaches that the purpose of using an inert gas is to reduce attenuation of ArF excimer light as it passes through the optical systems. (para. [0008]). There is no teaching or suggestion in either Tanaka or Klebanoff that the inert gas of Tanaka can be replaced by the hydrocarbons of Klebanoff. Indeed, doing so would destroy the functionality of Tanaka. Thus, there is no motivation to combine the two references as applied to the claims of the present application, and the asserted combination is improper.

Because all of the rejections depend on the improper combination of Klebanoff with Tanaka and because Duveneck fails to overcome the deficiencies of the asserted combination, Applicants respectfully request that the rejections be withdrawn.

CONCLUSION

All objections and rejections having been addressed, it is respectfully submitted that the present application is in a condition for allowance and a Notice to that effect is earnestly solicited.

If any point remains in issue which the Examiner feels may be best resolved through a personal or telephone interview, please contact the undersigned at the telephone number listed below.

Please charge any fees associated with the submission of this paper to Deposit Account Number 03-3975 Under Order No. 081468/282980. The Commissioner for Patents is also authorized to credit any over payments to the above-referenced Deposit Account.

Respectfully submitted,

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